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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,651	12/16/2003	Hugh E. McLoone	003797.00787	3533
28319	7590	12/28/2004	EXAMINER	
BANNER & WITCOFF LTD., ATTORNEYS FOR MICROSOFT 1001 G STREET, N.W. ELEVENTH STREET WASHINGTON, DC 20001-4597			NGUYEN, ANTHONY H	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,651

Applicant(s)

MCLOONE ET AL.

Examiner

Anthony H Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 6-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,712,535. Although the conflicting claims are not identical, they are not patentably distinct from each other because the slightly different and broader claim language.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al. (US 6,307,535).

Kim et al. teaches a keyboard 104 having a rotatable wheel 40 which has a width that is greater than the diameter of the rotatable wheel as shown in Figs. 11 and 12A of Kim et al.

Claims 2 and 10-12 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Kim et al.(US 6,307,535) in view of Bruck et al. (US 6,677,927)

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With respect to claims 2 and 10, Kim et al. teaches all that is claimed, except that Kim et al. does not clearly teach the rotatable wheel which is used to provide a scrolling command. Bruck et al. teaches a keyboard 18,20 having a rotatable wheel 28 configured to provide a scrolling command as shown in Figs. 1-2B. In view of the teaching of Bruck et al., it would have been obvious to one of ordinary skill in the art to modify the rotatable wheel of Kim et al. for providing the scrolling command as taught by Bruck et al. to improve the efficiency of using a keyboard with a rotatable wheel. With respect to claim 10, the use of a rotatable wheel has a frustum-shape member is well known in the art.

With respect to claims 11 and 12, Kim et al. teaches all that is claimed, except the axis of the rotatable wheel extending laterally relative to the keyboard. Bruck et al. teaches the axis of the rotatable wheel 28 which is extended laterally relative to the keyboard 120 or 150 (Bruck et al., Figs. 8 and 9). In view of the teaching of Bruck et al., it would have been obvious to one of ordinary skill in the art to modify the keyboard of Kim et al. by placing the axis of the rotatable wheel extending laterally to the keyboard as taught by Bruck et al. for ease of operating the rotatable wheel while typing on the keyboard.

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Griffin et al. (US 6,489,950).

Griffin et al. teaches a keyboard 4008 having a rotatable frustum-shaped member or a rotatable wheel 4002 which has the outer diameter at the first side which is larger than the outer diameter at the second side as shown in Figs. 9-11 of Griffin et al.

Claims 6 and 7 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Griffin et al. (US 6,489,950) in view of Kim (US 6,404,415).

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Griffin et al. teaches a keyboard having a rotatable frustum-shaped member 4002 located in the ridge 4010 as shown in Figs.9 and 11 of Griffin et al. Griffin et al. does not teach clearly the raised ridge. Kim teaches a keyboard 26 having a planar section 60, a raised ridge (no numeral reference, between 66,68) in which the rotatable wheel 82 is located as shown in Figs.2-4 of Kim. In view of the teaching of Kim, it would have been obvious to one of ordinary skill in the art to modify the keyboard of Griffin et al. by providing a raised ridge as taught by Kim for protecting a rotatable wheel from inadvertently rotating the wheel.

Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Gilligan et al. (US 5,438,331).

Gilligan et al. teaches the input element 21 or 32 which is inherently less than 2.5 cm from the rotatable frustum-shaped member 30. Note that the use of an input element which provides a back command is well known in the art.

Response to Arguments

Applicant's arguments with respect to claims 1, 2, and 9-12 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that Bruck or Griffin fails to teach the limitations as recited in the amended claims 1 and 3 and that the prior art as applied is improper hindsight reconstruction the limitations of the claims and does not teach the Cut key located within 3 cm of a rotatable frustum-shaped member as recited in amended claims 3, 4 and 9.

However, the arguments with respect to claims 1, 9 and 6 are not persuasive in view of the new ground of rejection.

Allowable Subject Matter

As presently advised it appears that claims 3,4,8 and 13 avoid the prior. These claims would be allowable subject to the timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c).

The primary reason for allowance claim 3 is that the prior art of record does not teach the keyboard having an alphanumeric section and a rotatable wheel having an outer diameter at a first larger than the outer diameter at the second side and that the first side being proximal to alphanumeric section than the second side.

The primary reason for allowance claims 4 and 13 is that the prior art of record does not teach the Cut key, a Copy key, a Paste key at least one of which is within 3 cm of the rotatable frustum-shape member or the rotatable wheel.

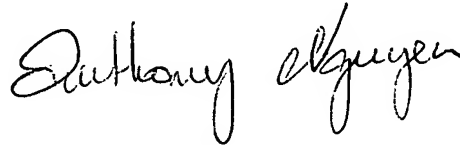
Conclusion

The patent to Manser et al. is cited to show other structure having obvious similarities to the claimed structure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (571) 272-2169. The examiner can normally be reached daily from 9 AM to 5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (571) 272-2168. The fax phone number for this Group is (703) 872-9306.

A handwritten signature in black ink, reading "Anthony Nguyen". The signature is written in a cursive, flowing style.

Anthony Nguyen
12/20/04
Patent Examiner
Technology Center 2800